



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
WASHINGTON, DC 20590
www.uspto.gov

APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 932,451	08 17 2001	Kenya Ozawa	0800-0026	3418

31048 7590 12 16 2002

ROBINS & PASTERNAK LLP
545 MIDDLEFIELD ROAD
SUITE 180
MENLO PARK, CA 94025

EXAMINER

WHITEMAN, BRIAN A

ART UNIT PAPER NUMBER

1635

DATE MAILED 12 16 2002

69

Please find below and or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,451

Applicant(s)

OZAWA ET AL.

Examiner

Brian Whiteman

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Fig. 1 is a block diagram of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 4) ☐ Interview Summary (PTO-413) (Paper Note)

Art Unit: 1635

DETAILED ACTION

Claims 1-40 are pending.

Non-Sequence Compliance

No "SEQ ID NO: ___" next to sequence(s) in the specification. The paper/CD copy and CRF are correct and entered. Page 25 of the specification list nucleotide sequences with no SEQ ID NO: (See MPEP 2422.01). In response to this action, these sequences and any other sequences listed in the specification that are not in compliance with sequence rules must be in compliance with M.P.E.P. 2400; 37 C.F.R. 1.821 – 1.825 or the response will be considered non-responsive.

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention: rAAV virions comprising a gene encoding an angiogenic factor(s) selected from VEGF, FGF, angiopoietin-1.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 12 are generic.

NOTE: if applicants do not elect vascular endothelial growth factor, claims 29-40 will be considered drawn to a non-elected species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are allowable is considered insufficient to overcome this requirement. The elected species must be a species specifically disclosed in the specification.

claims to additional species which are written in dependent form or otherwise include all the

Art Unit: 1635

limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Claims 1, 12, 29, and 35 are generic to a plurality of disclosed patentably distinct species comprising skeletal, cardiac, and smooth muscle. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

NOTE: if applicants do not elect vascular endothelial growth factor as the angiogenic factor, claims 29-40 will considered drawn to a non-elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Whitman, whose telephone number is (570) 295-6775.

Standard Time), with alternating Fridays off.

Art Unit: 1635

If attempts to reach the examiner by telephone are unsuccessful, the examiner's mentor, primary examiner, Scott Priebe can be reached at (703) 308-7310.

If attempts to reach the primary examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader, SPE - Art Unit 1635, can be reached at (703) 308-0447.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Brian Whiteman
Patent Examiner, Group 1635
12/12/02

Scott D. Priebe
SCOTT D. PRIEBE, ELD
PATENT EXAMINER